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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,258	07/30/2001	Steve Packwood	06005/36578	2238
4743	7590	06/03/2004	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP 6300 SEARS TOWER 233 S. WACKER DRIVE CHICAGO, IL 60606			LEFKOWITZ, SUMATI	
			ART UNIT	PAPER NUMBER
			2112	5

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/918,258

**Applicant(s)**

PACKWOOD ET AL.

**Examiner**

Sumati Lefkowitz

**Art Unit**

2112

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on 13 February 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,8-13,20-23 and 25 is/are rejected.
- 7) Claim(s) 2-7,14-19 and 24 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 30 July 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. 5.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

1. Claims 1-25 are pending.

### *Specification*

2. The disclosure is objected to because of the following informalities:
  - the "Brief Description of the Drawings" makes reference to Figure 5 only, not both Figures 5A and 5B
  - [0045] makes reference to Figure 5 only, not both Figures 5A and 5BAppropriate correction is required.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 8-13, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by

Warrior, 5,764,891.

- a. As to claims 1 and 13, Warrior discloses a field device (note abstract, Figures 1 and 2) for use in a process control system having a digital data bus (note Figure 2, loops 70 and 18), comprising a first communications interface (note Figure 2, FB Interface 30 and 36) communicatively coupled to the digital data bus that is adapted to process communications

having a first protocol (i.e., Field bus), a second communications interface (note Figure 2, Transmitter Interface 34 and 35) communicatively coupled to the digital data bus that is adapted to process communications having a second protocol (i.e., HART) different from the first protocol, a memory (note Figure 2, memory 48), and a processor (note Figure 2, processors 38 and 66) communicatively coupled to the memory, the first communications interface and the second communications interface, wherein the processor is programmed to process the communications having the first protocol and the communications having the second protocol (note column 3, line 35 – column 5, line 46).

- b. As to claims 8 and 20, Warrior discloses that the first protocol is a HART communication protocol and wherein the second protocol is a Fieldbus communication protocol.
- c. As to claims 9, Warrior discloses that the first communications interface includes a modem (note Figure 2, modem 68).
- d. As to claim 10, Warrior discloses that the first communications interface further includes an amplitude adjustment circuit (note Figure 2, power conversion 72 and column 4, lines 11-17) coupled to an output of the modem.
- e. As to claim 11, Warrior discloses that the second communications interface includes a media access unit (note Figure 2, elements 30, 60, 62, 64) and a protocol conversion unit (note Figure 2, element 66) coupled to the media access unit.
- f. As to claim 12, Warrior discloses that the memory contains a first software routine for processing the communications having the first communication protocol and a second software routine for processing the communications having the second communication protocol (note column 3, lines 49-51, wherein it is inherent that the memory contains instructions for

processing both HART and Field bus signals, since the device interfaces with both types of signals).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 21-23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warrior, 5,764,891 in view of Applicant's Admitted Prior Art (hereinafter AAPA).

a. As to claim 21, Warrior discloses receiving communications having the second protocol different from the first protocol in the field device via the digital data bus, but fails to disclose using a portable configuration tool proximate to the field device to send the communications having the second protocol.

AAPA discloses the step of using a portable configuration tool proximate to the field device to send the communications having the second protocol (note [0005]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of a portable configuration tool proximate to the field device to send the communications having the second protocol, as AAPA teaches, in the system of Warrior so as to locally configure the field device, as AAPA teaches in [0005].

b. As to claim 22, AAPA discloses that using the portable configuration tool proximate to the field device to the send the communications having the second protocol includes the step of using a HART communicator (note [0005]).

c. As to claim 23, Warrior discloses a field device having a first communications interface (note Figure 2, elements 30 and 36) for processing communications having a first protocol (i.e., Fieldbus protocol) and a second communications interface (note Figure 2, elements 34 and 36) for processing communications having a second protocol (i.e., HART protocol).

Warrior fails to disclose a method of locally configuring the field device, the method comprising the steps of communicatively coupling the portable configuration tool to the field device; and sending configuration information from the portable configuration tool to the field device using the second communication protocol.

AAPA discloses a method of locally configuring the field device, the method comprising the steps of communicatively coupling the portable configuration tool to the field device, and sending configuration information from the portable configuration tool to the field device using the second communication protocol (i.e., HART protocol) (note [0005]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of a portable configuration tool proximate to the field device to send the communications having the second protocol, as AAPA teaches, in the system of Warrior so as to locally configure the field device, as AAPA teaches in [0005].

d. As to claim 25, AAPA discloses that the step of sending configuration information from the portable configuration tool to the field device using the second communication protocol includes the step of using a HART communication protocol to send the configuration information (note [0005]).

*Allowable Subject Matter*

7. Claims 2-7, 14-19, and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure, as the prior art teaches or suggests field devices operating in accordance with various protocols.

US PG-PUBS: 2004/0073402 A1 DelaCruz et al.

2002/0167904 A1 Borgeson et al.

US Patents: 6,629,059 Borgeson et al.

6,449,715 Krivoshein

6,266,726 Nixon et al.

5,923,557 Eidson

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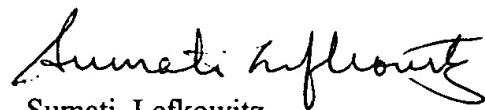
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sumati Lefkowitz whose telephone number is 703-308-7790. The examiner can normally be reached on Monday-Friday from 6:00-2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached at 703-305-4815.

The fax phone numbers for the organization where this application or proceeding is assigned are:

703-746-7238	for After-Final communications
703-872-9306	for Official communications
703-746-5661	for Non-Official/Draft communications

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

  
Sumati Lefkowitz  
Primary Examiner  
Art Unit 2112

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May 28, 2004